

Remarks

A. Pending Claims

Claims 60, 73-75, 79, 92-94, 107, and 108 have been amended. Claims 64, 66-67, 76-78, 83, 85, 86, 98, 100, 101, and 109-115 have been cancelled. Claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99, and 102-108 are pending in the case.

B. The Claims Are Directed to Statutory Subject Matter Pursuant To 35 U.S.C. § 101

The Examiner rejected claims 60-77, 80-93, 99, 101-105, and 107-115 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 60 and 75 have been amended for clarification. Applicant respectfully requests the Examiner withdraw the rejection to claims 60 and 75 and claims dependent on claims 60 and 75.

Furthermore, Applicant respectfully submits that claims 80-93 are dependent on claim 79 which recites “program instructions which are executable by the CPU.” Applicant respectfully requests the Examiner withdraw the rejection to claims 80-93.

Applicant also notes claims 99, 102-105, and 107-108 are dependent on claim 94 which recites “program instructions are computer-executable.” Applicant respectfully requests the Examiner withdraw the rejection to claims 99, 102-105, and 107-108.

C. The Claims Are Not Obvious Over Borghesi in View of Abbruzzese Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 60-115 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,950,169 to Borghesi et al. (hereinafter “Borghesi”) in view of U.S. Patent No. 5,557,515 to

Abbruzzese et al. (hereinafter "Abbruzzese"). Applicant respectfully disagrees with the rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Amended claim 60 recites:

A method for processing an insurance claim on a computer system to estimate a value of the insurance claim, the method comprising:

- displaying a first insurance claim processing step on a display device coupled to the a computer system;
- receiving input regarding the first insurance claim processing step;
- automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step;
- automatically displaying a table of contents on the display device, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps;
- selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and
- automatically displaying the second insurance claim processing step on the display device;
- receiving input regarding the second insurance claim processing step; and
- automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step.

Support for the amendments to the claim can be found in Applicant's specification. For example, Applicant's specification states:

A table of contents may be displayed upon the entry of an appropriate command by the user, wherein the table of contents includes an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first step, the intermediary step, and any steps in between the first step and the intermediary step. The ordered list of steps may be dynamically modifiable in response to the entry of information in a step. In other words, steps may be added to or deleted from said dynamically modifiable ordered list of steps in response to the entry of information.
(Specification, page 3, lines 22-29)

The inclusion or exclusion of a display screen in a table of contents display screen may be based on business rules, user inputs, etc. In another embodiment, the business process for processing the insurance claims may utilize all display screens.
(Specification, page 12, lines 22-25)

The table of contents may include an ordered list of the steps associated with the processing of the insurance claim, and the ordered list of steps may include the first step, the intermediary step, and any steps in between the first step and the intermediary step. Therefore, the table of contents may essentially show a "roadmap" of the business process for processing insurance claims. The ordered list of steps may be dynamically modifiable in response to the entry of information in a step. In other words, steps may be added to or deleted from said dynamically modifiable ordered list of steps in response to the entry of information. In various embodiments, the table of contents may be shown as a display screen, window, or other subset of a screen.
(Specification, page 16, lines 18-27)

Amended claim 60 includes, but is not limited to, the feature of:

automatically displaying a table of contents on the display device, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps

Applicant submits that this feature does not appear to be taught or suggested by the cited art. The

Office Action cites Borghesi (Col. 8, lines 30-67) as reciting this feature. The cited portion of Borghesi states:

As shown in FIG. 6, the perspective panel 84 may be selected as always visible regardless of what point of the claims processing a user is at. Regardless of whether a user is using a local area network (LAN), a wide area network (WAN) or a stand alone computer, the in box 86 retains all the mail addressed to the particular user. The out box 88, which is located on the same screen as the in box 86, is also essentially independent of the type of network or stand alone computer a user happens to be working on. Mail is sent from the out box whenever a user confirms the completion of the files contained in the out box 88. Both the in box and the out box are connected through network connections described above so that assignments, entire workfiles, and miscellaneous claim information may be passed back and forth. In one preferred embodiment, users do not have individual in and out boxes but are able to filter the contents of a central in or out box so that it may selectively view the contents. In another preferred embodiment, each individual user is assigned an in box containing only those electronic datafiles relevant to the particular user.

The in process box 90 is used for those workfiles a user is working on. A workfile remains within the in process box 90 for as long as it takes to complete the various steps or transactions required for the particular work file. This time will of course vary with the complexity of the claim that the workfile represents. When the in process icon is selected, the graphic user interface displays the number of items or work files in process, with each workfile appearing as a folder in the main screen area. Each folder is identified by the insured's name; make of the vehicle; date; and job number assigned. To open a particular workfile with a mouse, the user can either double-click on the desired folder or use the "open" button provided near the top of the screen. Keyboard access to workfiles may be achieved through use of arrow keys, the space bar and the "enter" key.

Within the in process box, an individual workfile opened for work on a display monitor is shown in FIG. 6. The workfile preferably comprises a plurality of individual sections represented by tabs 102 that designate the contents of that section. In one preferred embodiment, a section tab extension 104 is included to allow for extra sections to be referenced without cluttering up a viewer's screen. Within each of the sections of the workfile, a frame switching button bar 106 having a number of frame switching buttons is included.
(Borghesi, col. 8, line 30 - col. 9, line 7)

Applicant submits that Borghesi appears to teach the display of various actions that may

be taken on an insurance claim processing file. Specifically, Borghesi states that a workfile includes “a plurality of individual sections represented by tabs 102 that designate the contents of that section.” Applicant submits, however, that there does not appear to be any particular order given to the tabs displayed in the system of Borghesi. For example, FIG. 6 of Borghesi appears to be a representation of the “universal display screen” described above. Applicant submits that while certain processing categories are displayed, there does not appear to be any representation of processing steps or a specific order for processing the insurance claim. Applicant’s claims are directed to a method of processing an insurance claim using a computer system which includes, but is not limited to, the feature of “automatically displaying a table of contents on the display device, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim.” As recited in Applicant’s specification:

The table of contents may include an ordered list of the steps associated with the processing of the insurance claim, and the ordered list of steps may include the first step, the intermediary step, and any steps in between the first step and the intermediary step. Therefore, the table of contents may essentially show a “roadmap” of the business process for processing insurance claims.
(Specification, page 16, lines 18-23)

Amended claim 60 includes, but is not limited to the feature of “automatically displaying a table of contents on the display device, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim automatically.” The Office Action cites Abbruzzese with respect to the feature of “an ordered list.” The cited section of Abbruzzese states:

Upon completion of the LPTX Interface screen, the `Enter` key is pressed and a series of loss screens particular to a single "line of business" are displayed. The loss screens are formatted according to a policy symbol (indicating the type of policy) and the line of business specified on the Interface screen. These screens contain policy/insured and loss/claim description data. The number of screens and their sequence is relative to the number of claims arising from the loss occurrence and the manner in which the loss was reported.

The initial screens accessed contain fields for inputting required information that applies to the entire loss occurrence. Reporting screens are used to record information which is specific to an individual claim arising out of the loss occurrence. Screens are also available for entering Witness, Contact/Comment information and Special Procedures, if applicable. Where the Loss Notice is received electronically from agents, insureds, customers or a central reporting center, the information is in a form which is used to prefill fields in the LPTX. The electronically reported information must be reviewed for accuracy but this type of reporting substantially reduces input time.

The following is a list of screens specific to the automobile line of insurance business (which will be used as an example for purposes of this description) in their logical order of appearance (screens marked with asterisks will potentially become new claims):

- Policy Information Screen (required)
- Special Procedures (optional unless extracted from Policy Index Table)
- Description of Accident (required)
- *Claimant Screen (required)
- *Physical Damage screen (required for certain types of policies--identified by claim symbol)
- *Property Damage screen (required for certain types of policies)
- *Injured Party Information screen (required for certain types of policies)
- Witness/Passengers screen (optional)
- Contact/Comment screen (optional).

Abbruzzese appears to teach the display of screens for entering insurance information. Specifically, Abbruzzese appears to teach that after initialization information is received a “a series of loss screens particular to a single ‘line of business’ are displayed.” The “number of screens and their sequence is relative to the number of claims arising from the loss occurrence and the manner in which the loss was reported.” Although Abbruzzese teaches an ordered sequence of insurance claim processing steps, Abbruzzese does not appear to teach or suggest the use of a “table of contents” to display the list of processing step. Instead, Abbruzzese appears to teach using a predetermined sequence to display the screens necessary to process an insurance claim. Applicant submits that Abbruzzese does not appear to teach or suggest that the sequence of the screens, or an indication of what screens will be displayed, would be visible to the user at any time.

Applicant further submits that the combination of Borghesi and Abbruzzese does not appear to teach the features of Applicant's claims. Applicant's claim 60 further includes, but is not limited to the feature of:

automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step

As discussed before, Borghesi appears to teach that multiple processing categories are displayed, however there does not appear to be any representation of processing steps or a specific order for processing the insurance claim. Abbruzzese appears to teach the display of insurance claim processing screens in a specific order, but not to display the specific order. Applicant submits, however, that neither Abbruzzese or Borghesi, either alone or in combination, appear to teach adding or deleting processing steps based on a user's input. Applicant further submits that neither Abbruzzese or Borghesi, either alone or in combination, appear to teach modifying the sequence of steps based on a user's input.

For at least these reasons, Applicant submits that neither Borghesi nor Abbruzzese alone or in combination appear to teach or suggest this feature. To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Claim 73 describes features including: "wherein insurance claim processing steps are associated with table of contents properties." Applicant submits that the passage in Abbruzzese cited by the Examiner does not appear to teach or suggest insurance claim processing steps associated with a table of contents. The Examiner cited passage of Abbruzzese appears to teach accessing a database. For example, Abbruzzese states:

The Directory Tables are used to store and display names, addresses and other pertinent information about currently used services and individuals. These

include attorneys, doctors/hospitals, investigating authorities, etc. Each listing in the Directory Tables is automatically assigned a unique directory code upon initial input. (Abbruzzese, column 39, line 43 – column 40, line 25)

Applicant respectfully requests removal of the rejections of claim 73.

Amended claim 75 describes a combination of features including: “determining a table of contents associated with the claim identifier, wherein the table of contents represents one or more steps for processing the insurance claim, and wherein at least one step comprises an end step.” As stated by the Examiner, Borghesi does not appear to teach or suggest a table of contents associated with a claim identifier. Applicant submits that Abbruzzese also does not appear to teach or suggest a table of contents associated with a claim identifier. Instead, Abbruzzese appears to teach menu screens that list system functions or transactions for a given operator. For example, Abbruzzese states:

The menu screens serve as a table of contents enabling an operator to select a desired system function or transaction. Following a successful logon, the System displays a Default Primary Menu tailored to the operator’s specific needs. (See, e.g., Tables I and II, for screens designed for a claim handler and a supervisor). The appropriate Primary Menu screen for a particular operator is determined by a Default Menu Number which is entered in the operator’s Staff Table. (Abbruzzese, column 17, lines 22-30)

Applicant respectfully requests removal of the rejection of claim 75 and the claims dependent thereon.

Amended claim 79 recites:

79. A computer system for processing an insurance claim to estimate a value of the insurance claim, the computer system comprising:
a CPU;
a display device coupled to the CPU;
a memory coupled to the CPU, wherein the memory stores program instructions which are executable by the CPU to:
display a first insurance claim processing step;

receive input regarding the first insurance claim processing step;

automatically determine a table of contents in response to input received regarding the first insurance claim processing step;

automatically display a table of contents, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps;

select a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents;

automatically display the second insurance claim processing step on the display device; and

automatically add or delete one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modify the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step.

Applicant submits, for at least the reasons described above, that amended claim 79, and the claims dependent from amended claim 79, are patentable over Borghesi in view of Abbruzzese. Applicant respectfully requests removal of the rejection of claim 79 and claims dependent thereon.

Amended claim 94 recites:

94. A carrier medium comprising program instructions for processing an insurance claim on a computer system to estimate a value of the insurance claim, wherein the program instructions are computer-executable to implement:

displaying a first insurance claim processing step;

receiving input regarding the first insurance claim processing step;

automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step;

automatically displaying a table of contents, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps;

selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents;

automatically displaying the second insurance claim processing step on the display device; and

automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step.

Applicant submits, for at least the reasons described above, that amended claim 94, and the claims dependent from amended claim 94, are patentable over Borghesi in view of Abbruzzese. Applicant respectfully requests removal of the rejection of claim 94 and claims dependent thereon.

D. Additional Remarks

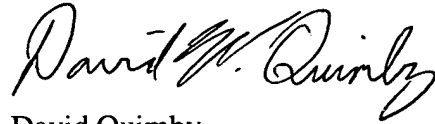
Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

Applicant respectfully requests a one-month extension of time to respond to the Office Action dated January 14, 2004. A fee authorization form in the amount of \$110.00 is enclosed for the extension of time fee. If any further extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are omitted or if any additional fees are

Inventors: Childress et al.
Appl. Ser. No.: 09/603,307
Atty. Dkt. No.: 5053-27600

required or have been overpaid, please appropriately charge or credit those fees to Meyertons,
Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-27600/EBM.

Respectfully submitted,



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Date: MAY 14, 2004